

REMARKS: REQUEST FOR RECONSIDERATION

The Advisory Action mailed 07/31/2009 indicates that Applicant's reply filed July 24, 2009 has overcome the objection to claims 12, 50 and 54-56, that claims 1-6, 8, 10, 12, 45-50 and 54-64 are allowable and that claims 67-77 are still objected to.

Applicant Requests Reconsideration Of the Objection to Claims 67-77

With respect to the objection that claim 67 is duplicative of Claim 1, Applicant respectfully requests reconsideration. In support of this request, Applicant attaches hereto a copy of M.P.E.P. § 2173.05(n), as well as a copy of In re Flint cited in § 2173.05. M.P.E.P. § 2173.05(n) points out that a rejection for "undue multiplicity" is to be made under 35 U.S.C. § 112, second paragraph, and that such rejections "should be applied judiciously and should be rare."

The attached case of In re Flint involved four independent claims and a total of 42 claims. Each of the four independent claims differed in scope. The Court of Customs and Patent Appeals reversed the Board's holding of "undue multiplicity" stating:

...the board's statement acknowledges a difference in scope between the base claims, thus rendering persuasive appellant's argument pointing out that only four independent claims are present, three of which have been held allowable over the art, and that logically the sets of dependent claims differentiate themselves from each other by the differences in scope of the independent claims.
(Emphasis added)

The subject application is virtually identical to that at issue in In re Flint in that the subject application now has 39 claims and four independent claims. Claims 1 and 67 which are asserted to duplicate have clear differences in scope as previously pointed out and reiterated below. Therefore, under In re Flint, there is no legal basis whatsoever to object or reject the claims of the subject application as unduly multiplied. Therefore, Applicant respectfully requests that claims 67-77 be allowed.

For ease of reference, Applicant sets forth below the previously submitted argument demonstrating the difference in scope between Claims 1 and 67, with the pertinent recitation of Claims 1 and 67 disposed adjacent one another:

Claim 1	Claim 67
(1) a first plurality of physical paint sample cards arranged on the display unit according to groups of different hue and chroma with the paint colors on the physical paint sample cards varying in hue, in a first direction, and varying in chroma, in a second direction; and	(1) a first plurality of physical paint sample cards, <u>each of the plurality of physical paint sample cards having one or more paint colors displayed thereon, the one or more colors being selected and positioned such that</u> the first plurality of physical paint sample cards are arranged adjacent one another such that the colors thereon vary in hue in a first direction and vary in chroma in a second direction; and
(2) one or more physical color combination paint sample disposed adjacent to <u>each group of different hue and chroma physical paint sample cards</u> , each physical color combination paint sample card containing <u>a plurality of paint samples having the same base hue</u> as the hue of the group it is adjacent to. and a picture of a building or a room painted with the plurality of colors on the physical color combination paint sample card.	(2) one or more physical color combination paint sample cards arranged adjacent to <u>a first selected group of said physical paint sample cards</u> , each physical color combination paint sample card containing a plurality of paint samples, each paint sample having a respective color, <u>one of the paint samples having a hue which is the same as a base hue of the first selected group</u> of said physical paint sample cards, each respective physical color combination paint sample card further having a picture of a building or a room painted with each of the plurality of respective colors of each of the paint samples on that physical color combination paint sample card.

Applicant has underlined the claim language differences to show that Claims 1 and 67 are not substantial duplicates of one another.

As may be seen, the second listed limitations “(2)” of Claims 1 and 67 differ materially in scope in that Claim 1 recites “one or more physical color combination paint sample cards disposed adjacent to each group of different hue and chroma paint sample cards,” while Claim 67 recites “one or more physical color combination paint sample cards arranged adjacent to a first selected group of said physical paint sample cards.” Additionally, the second listed limitation of Claim 1 recites “a plurality of paint samples having the same base hue...”, while that of Claim 67 recites “one of the paint samples having a hue which is the same as a base hue...”

To further highlight the fact that Claims 1 and 67 are not substantial duplicates of one another, Applicant observes that the first listed limitation “(1)” of Claim 1 contains 47 words, while the adjacent limitation of claim 67 contains 70 words. Similarly, the second listed recitations “(2)” of these two Claims contain 73 words and 110 words, respectively. Thus, in some instances, Claim 67 contains more specific recitations than Claim 1. As may be seen, for example, the first limitation “(1)” of Claim 67 contains the underlined 28 word recitation “each of the plurality of physical paint sample cards... positioned such that...” which is entirely absent from Claim 1.

For these reasons, Applicant respectfully submits that Claim 1 and 67 are not substantial duplicates and respectfully requests withdrawal of the objection to Claims 67-77, which would place the application in condition for allowance.

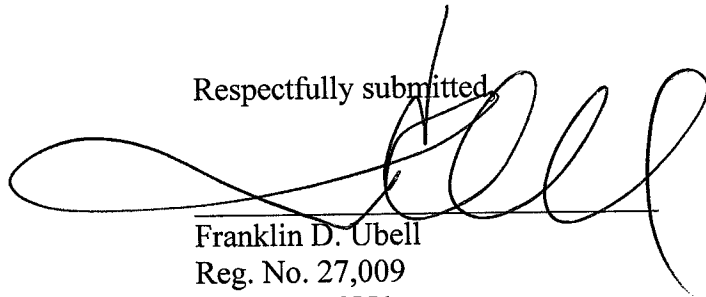
CONCLUSION

Applicant believes that this case is now in good condition for allowance, and an early Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 076360.011600 is referred to when charging any payments or credits for this case.

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Respectfully submitted,



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